

REMARKS

Claims 1 and 3-18 are pending in the present application. The Examiner has rejected claims 4-18 under 35 U.S.C. §101, and has rejected claims 1-18 under 35 U.S.C. §103(a).

Section 101 Rejection

The Examiner rejected claims 4-18 under 35 U.S.C. §101 based on Applicant's interpretation of the word "units" appearing in claims 4 and 11. Applicant urges that the "units" of claims 4 and 11 need not be separate, explicit hardware units. The Examiner alleges that software units are directed to functional descriptive material that is non-statutory.

Applicant respectfully disagrees.

The Examiner alleges that for software claims to be statutory, they must be claimed in combination with an appropriate medium and/or hardware to establish a statutory category of invention and to enabled functionality, citing *In re Lowry*, 32 USPQ2d 1031, and *In re Warmerdam*, 31 USPQ2d 1754. Applicant urges that the Examiner's reliance on these cases is misplaced, as both were superseded by the Federal Circuit's decisions in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (1998) and *AT&T v. Excel Communications Inc.*, 172 F.3d 1352 (1999). In *State Street*, the Federal Circuit held that application of a mathematical or computer algorithm can constitute a practical application if it produces a useful, concrete and tangible result. In other words, a software application that produces a useful, concrete and tangible result is statutory subject matter. The Federal Circuit emphasizes this point by stating, "[t]he question of whether a claim encompasses statutory subject matter should not focus on *which* of the four categories of subject matter a claim is directed to--process, machine, manufacture, or composition of matter--but rather on the essential characteristics of the subject matter, in particular, its practical utility." 149 F.3d at 1375. As Applicant stated in the response filed April 3, 2008, a system and method for

analyzing and utilizing intellectual property information does provide useful, concrete and tangible results. The Examiner's allegation that this is irrelevant shows the Examiner's improper understanding of the Federal Circuit's caselaw on the issue of patentability of software-related inventions, and the *State Street* and the *AT&T v. Excel* cases have yet to be overruled. There is no need for software to be claimed in combination with an appropriate medium and/or hardware. It is sufficient for the preambles of claims 4 and 11 to state that the claims are directed to a *computer-based system for analyzing and utilizing intellectual property (IP) information*. Furthermore, the elements of claims 4 and 11 clearly recite that the claimed systems produce such useful, concrete and tangible results as *extracting IP information . . . from . . . [an] on-line IP information database . . . and providing the extracted IP information to the IP information analyzing unit, . . . transmitting the extracted IP information . . . to the research center analyzing unit, and receiving feedback of the data containing the opinion contents from the research center analyzing unit, wherein . . . the research center analyzing unit determines whether the extracted IP information includes IP information that is related to at least one project accessible by the research center analyzing unit . . . and . . . requesting detailed information corresponding to the IP information . . .* Reconsideration and withdrawal of these section 101 rejections are respectfully requested.

Section 103 Rejections

Claims 1 and 3 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,721,910 (Unger, *et al.*) in view of U.S. Patent Application Publication No. 2003/0033295 (Adler, *et al.*).

Claims 4-17 were rejected under 35 U.S.C. §103(a) as being obvious over Unger in view of Adler and further in view of U.S. Patent No. 5,862,223 (Walker, *et al.*).

Claim 18 was rejected under 35 U.S.C. §103(a) as being obvious over Unger in view of Adler and Walker, and further in view of U.S. Patent No. 6,088,765 (Ohtsuka).

Regarding claims 1, 4, and 11, the Examiner cited Unger, col. 3, lines 46-51 as disclosing transmitting the first IP information converted in the standard form to a research center analyzing unit and transmitting the second IP information converted in the standard form to the research center analyzing unit, as recited in claim 1. This section of Unger states:

The documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model. The documents and/or abstracts and/or claims and/or technical indexing may be displayed on a computerized graphical interface.

This passage is concerned with how data is stored in a database, and linked to a hierarchical model. Thus, contrary to the Examiner's allegation, there is nothing in this passage about *transmitting the first IP information . . . to a research center analyzing unit, or transmitting the second IP information . . . to the research center analyzing unit.*

The Examiner also cited Unger, col. 2, lines 40-46 as disclosing *accessing the Internet websites and extracting second IP information corresponding to the first IP information upon a request for detailed information.* This section of Unger states:

Specific detail on individual documents and/or abstracts and/or claims may also be captured in discrete fields and linked to the categories within the hierarchical model and the technical documents and/or abstracts and/or claims. All of the above data may also be linked to full-text sources of the documents.

Again this passage is concerned with how data is linked to the categories of a hierarchical model. Thus, contrary to the Examiner's allegation, there is nothing in this passage about *extracting second IP information corresponding to the first IP information upon a request for detailed information.*

The Examiner cited Unger, col. 10, lines 40-48 and col. 11, lines 34-45 as disclosing *determining if third IP information has been received from the research center analyzing unit, the third IP information including technical analyses and opinion contents.* The relevant paragraph in col. 10 of Unger is directed to applying mathematical

methods to derive more abstract concepts from the set of stored category assignments.

Col. 10, lines 40-48 states:

These more abstract concepts can be identified by the use of both the matrix of technical and/or scientific concepts, identified by the application of expert technical searches, and a matrix of stored expert opinion. The matrix of stored expert opinion represents the cumulative opinion of a group of expert technical staff and/or scientists, on the fractional contribution of each technical and/or scientific concept to each of the higher-level, more abstract concepts.

This passage is thus concerned with mathematical techniques to identifying abstract concepts in the stored categories. Col. 11, lines 34-38 states:

Table 5 represents the cumulative knowledge of a group of technical experts in a given business or technical entity. For example, Table 5 may represent the collective opinion of a group of technical experts on the contribution of a patent in Drill Bit Topology to a series of higher level concepts.

The remainder of the paragraph describes examples of cumulative knowledge. These passages do not disclose *determining if third IP information has been received from the research center analyzing unit, the third IP information including technical analyses and opinion contents*, contrary to the Examiner's allegation.

Thus, Applicant urges that Unger does not disclose or suggest *extracting first IP information according to a search strategy; transmitting the first IP information . . . to a research center analyzing unit; . . . determining if third IP information has been received from the research center analyzing unit, the third IP information including technical analyses and opinion contents . . . accessing the Internet websites and extracting second IP information corresponding to the first IP information upon a request for detailed information; and . . . transmitting the second IP information . . . to the research center analyzing unit*, as essentially recited in claims 1, 4, and 11. Unger only discloses a database and methods for producing and maintaining that database.

The Examiner cited Adler as disclosing a relevancy filter. Adler is directed to a computer implemented electronic records system and a data processing system for automatically maintaining an electronic laboratory records system. However, Applicant

urges that Adler fails to disclose or suggest a *an IP information extraction unit, an IP information analyzing unit, or a research center analyzing unit*, or Applicant's sequence of steps, and thus fails to rectify the deficiencies of Unger.

Thus, Applicant urges that since the combination of Unger and Adler fails to disclose or suggest all limitations of claim 1, this claim is not obvious over Unger and Adler. Reconsideration and withdrawal of this section 103 rejection are respectfully requested.

Regarding claims 4 and 11, the Examiner cited Walker as disclosing a system with an email receiving/transmitting unit. However, Walker is directed to managing communications between an expert having particular qualifications and an end user seeking a solution to an expert request. Walker fails to rectify the deficiencies of Unger and Adler discussed above.

Thus, Applicant urges that since the combination of Unger, Adler and Walker fails to disclose or suggest all limitations of claims 4 and 11, these claims are not obvious over Unger, Adler and Walker. Reconsideration and withdrawal of these section 103 rejections are respectfully requested.

Claims 3, 5-10, and 12-17 depend from claims 1, 4 and 11, respectively, and are thus patentable for at least the same reasons as claims 1, 4 and 11. Reconsideration and withdrawal of this rejection are respectfully requested.

Regarding claim 18, the Examiner cited Ohtsuka as disclosing a system in which predetermined intervals are determined based on the number of times a user connects to the computer-based system for analyzing and utilizing IP information. Ohtsuka is directed to a removable medium data storage apparatus that can read and store data. However, Applicant urges that Ohtsuka fails to rectify the deficiencies of Unger, Adler, and Walker as discussed above. Since the combination of Unger, Adler, Walker and Ohtsuka fails to disclose or suggest all claimed limitations of claim 18, a prima facie case of obviousness of claim 18 over Unger, Adler, Walker and Ohtsuka cannot be

maintained. Reconsideration and withdrawal of this section 103 rejection are respectfully requested.

CONCLUSION

Applicant urges that claims 1 and 3-18 are in condition for allowance for at least the reasons stated. Early and favorable action on this case is respectfully requested.

Respectfully submitted,

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